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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,452

05/23/2006

Balanda Atis

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22852

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,452	<b>Applicant(s)</b> ATIS, BALANDA	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/7/07</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt is acknowledged of election filed on 10/21/09 and IDS filed on 8/7/07.

Applicants' are notified that election of species is hereby withdrawn. Claims 1-20 are pending in the application.

#### ***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on 10/21/09 is acknowledged. The traversal is on the ground(s) that applicants disagree with the office analysis and reserves any further response until the issuance of an official action directed towards the patent and the elected subject matter. This is not found persuasive because as explained in the restriction requirement unity of invention is broken in view of Patent '745 and restriction is deemed proper between groups I-III.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13-15 and 20 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claims. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/21/09.

Claims 1-12 and 16-19 are examined in the application.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 12 and 16-19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U. S. Patent 6,479,040 ('040).

See example 5 drawn to mascara (claim 16). Stearic acid reads on claimed emulsifier of claim 1 and it is non aqueous. Stearic acid also reads on fatty acids of claims 2 and 17 and stearic

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acid of claims 3 and 18, the weight percent is 9% and it is between 0.2-10 wt percent of claim 4. PVP/Eicosene polymer reads on claim 5 drawn to film former, Bees wax reads on claimed wax of claim 6 and also claimed bees wax of claim 12. Hectorite reads on claim 7 drawn to thickening agent, mica reads on filler of claim 8, glycerine reads on solvent of claim 9 and colors reads on colorants of claim 10.

The claims are drawn to compositions and the intended use of claim 19 drawn to “eye liner” does not carry any patentable weight and therefore claim 19 is also anticipated by example 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,479,040 ('040) and 5,959,009 ('009).

Patent '040 teaches all the limitations except claim 11, wherein the film former is “styrene block copolymers”.

Patent '009 teaches mascara waterproofing compositions and teaches styrene block polymer as a gellant. See the abstract and teaches at col.2, ll 2-6 that the styrene-ethylene-propylene copolymer as gellant results in a clear shiny product which does not cloud the mascara when applied and also retains stability over a long period of time. See also col.2, ll 8-17. Patent

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at col.3, ll 14-25 teaches waxes like carnauba wax, fillers, thickening agents like carbomers, celluloses and gums.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '040 using the ingredients of example 5 and add styrene copolymer taught by patent '009 as a gellant with the reasonable expectation of success that the styrene copolymer does not cloud the mascara and the product retains stability over a prolonged time thereby resulting in a superior product taught by patent '009. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619